REMARKS/ARGUMENTS

Claims 1-5, 8-18, 21-32, 35-46, 49-56 and 59-81 are pending in this application. Claims 80-81 are newly added claims. Claims 1, 14, 27, 41 and 55 are independent claims. Support for the newly added claims may be found throughout the Specification and Drawings.

Claim Rejections – 35 USC § 103(a)

Claims 1-5, 8-18, 21-32, 35-46, 49-56, 59, 61-62, 64-65, 67-68, 70-71 and 73-79 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik et al. ("Malik", U.S. Patent Number 6,023,701) in view of Schmid ("Schmid", Web Representation with Dynamic Thumbnails) and Brown et al. ("Brown-2", U.S. Patent Number 6,278,448). Claims 60, 63, 66, 69, and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Schmid and Brown-2 and further in view of Gennaro et al. ("Gennaro", U.S. Patent Number 5,742,768). Applicant respectfully traverses these rejections.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent Claim 1 includes an element of "generating a representation of said linked second site" (emphasis added). In rejecting Claim 1, the Patent Office indicated that Malik "teaches ... generating and communicating a listing of hyperlinks of linked sites for presentation to the user (col. 2, lines 27-40)" (emphasis added) (Office Action, pages 2-3). Thus, the Patent Office has analogized a hyperlink itself to "representation" as recited in Claim 1. This is confirmed by "[a]lthough Ma[l]ik's hyperlinks of linked sites already contain information about the linked sites (i.e., labels or titles of the hyperlinks, e.g., www.ucberkley.edu or

www.washingtonpost.com) that are informative enough to users so that such a representation of information are interpretable to be previews of the linked sites" (emphasis added) (Office Action, page 3). Applicant respectfully disagrees with this analogy.

The "representation of said linked second site" element as claimed in Claim 1 is a representation separate from the hyperlink to the linked second site. That is, the "representation" element as claimed in Claim 1 cannot be the hyperlink itself as indicated by the Patent Office. This is supported throughout the specification of the present application. For example, "[r]eferring now to FIG. 1 ... A user may access a site 10 containing a link 20 to another site 30, such as a web site or page. To preview the linked site 30, a representation 22 of the linked site 30 may be generated and communicated to a user in the display of the site 10, in this example displayed proximally to the link 20" (emphasis added) (Specification, page 5, lines 12-20). As shown in FIG. 1 of the present application, the representation 22 of the linked site 30 is clearly separate from the link 20 and cannot be the link 20 itself. In addition, "[a]s shown in FIG. 3, representations may be generated by identifying descriptive information contained in the link, linked site tag, etc. For example, if a weather link 342 was identified, a weather representation 332 may be displayed" (emphasis added) (Specification, page 7, lines 16-19). As shown in FIG. 3 of the present application, the weather representation 332 is clearly separate from the weather link 342 and cannot be the weather link 342 itself.

Thus, Applicant respectfully submits that Malik fails to teach, disclose or suggest the element of "generating a representation of said linked second site" as recited in Claim 1.

Moreover, Claim 1 recites an element of "periodically updating the stored representation by at least one of the linked second site and the first site" (emphasis added). In rejecting Claim 1, the Patent Office first admitted that "Ma[l]ik and Schmid do not disclose the updating to take place periodically and the representation to be a stored representation" (Office Action, page 3, lines 15-16). Then, the Patent Office went on to allege that col. 1, lines 30-34 of Brown-2 discloses such element (Office Action, page 3, lines 16-18). Applicant respectfully disagrees.

Brown-2 "provides a mechanism for creating or customizing a user interface composite desktop by selecting various components and adding them to a desktop" (emphasis added) (col. 4, lines 12-14). Col. 1, lines 19-34 of Brown-2 recites:

> Prior art GUI desktops have represented such 'entry points' with icons, each of which typically fits a strict form factor (e.g., 32.times.32 pixels and a line or two of text). This type of representation does not scale well to the variety of resources on the World Wide Web, since it is limited in size, strict in form factor, and static (unchanging). The invention described here is designed to provide a way for a GUI desktop to more adequately provide 'entry points' to Internet resources (primarily, HTML-based Web pages); these 'entry points' scale better to Web pages because: a) they can be any size (customizable by user OR by the Web author); b) the representation is not strict, and so, for instance, instead of a static icon the entry point can be used to show a 'preview' of the Web pages they point to; and c) the representation is not static but can instead change over time to reflect the changing nature of the resource (e.g. Web page) (emphasis added).

Thus, even though "the representation" of Brown-2 may be a representation of a Web page, "the representation" of Brown-2 is still part of a GUI desktop. In other words, Brown-2 attempts to establish a link between an icon of a GUI desktop and a Web page, *not* a link between two Web pages.

This is different from Claim 1 where "a first site ... at least one of a link and a second site linked to said first site ... a representation of said linked second site" (emphasis added) is recited. To put it another way, "the representation" of Brown-2 is a representation of a site, *not* "a representation of said linked second site" (emphasis added) recited in Claim 1. In other words, Brown-2 only teaches a desktop and a "first site" and fails to teach a "second site" – the "second site" never comes into the picture in Brown-2. Thus, changing "the representation" of Brown-2 over time *cannot* be "periodically updating the stored representation," as recited in Claim 1.

Therefore, Brown-2 fails to teach, disclose or suggest "periodically updating the stored representation by at least one of the linked second site and the first site," as recited in Claim 1.

Furthermore, "to rely on a reference under 35 U.S.C. 103, it must be analogous prior art" (MPEP § 2141.01(a)). Here, the present invention "generally relates to network browsing" (emphasis added) (Specification, page 2, line 5). In contrast, Brown-2 "relates to the field of user interface desktops and, in particular, to methods and systems for incorporating content into such a desktop" (emphasis added) (col. 1, lines 5-7). Those of ordinary skill in the art will understand that "network browsing" is clearly different from "user interface desktops". Thus, Brown-2 is clearly nonanalogous art, and thus cannot be relied on to reject the present invention.

At least based on the foregoing reasons, the Patent Office has failed to establish a *prima facie* case of obviousness for Claim 1. Claim 1 therefore should be allowed.

Independent Claims 14, 27, 41 and 55 are similar in scope to Claim 1 and therefore should be allowed under similar rationale as applied to Claim 1.

Dependent Claims 2-5, 8-13, 60-62, 75 and 80-81; 15-18, 21-26, 63-65 and 76; 28-32, 35-40, 66-68 and 77; 42-46, 49-54, 69-71 and 78; and 56, 59, 72-74 and 79 depend from independent Claims 1, 14, 27, 41, and 55, respectively, and therefore should be allowed.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
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